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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,298	12/22/2008	George Theodoridis	60329-USA	7066
26111	7590	10/19/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				SHTERENGARTS, SAMANTHA L
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
10/19/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/595,298	THEODORIDIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Samantha Shterengarts	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 August 2011.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) Claim(s) 1-20 and 31-40 is/are pending in the application.
  - 5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6) Claim(s) 7-10,17-20 and 37-40 is/are allowed.
- 7) Claim(s) 1,6,11,16,31 and 36 is/are rejected.
- 8) Claim(s) 2-5,12-15 and 32-35 is/are objected to.
- 9) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments filed 22 August 2011 are acknowledged.
2. All rejections not explicitly maintained herein are withdrawn.
3. Claims 1-20 and 31-40 are pending.

### ***Claim Objections***

4. Claims 2-5, 12-15, 32-35 are objected to for depending on a rejected base claim.

### ***Election/Restrictions***

5. In accordance with the MPEP, if upon examination of the elected species, no prior art is found that would anticipate or render obvious the instant invention based on the elected species, the search of the Markush-type claim will be extended (see MPEP 803.02). If prior art is then found that anticipates or renders obvious the non-elected species, the Markush-type claim will be rejected. It should be noted that the prior art search will not be extended unnecessarily to cover all non-elected species. Should Applicant overcome the rejection by amending the claim, the amended claim will be reexamined. Id. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. Id. In the event prior art is found during reexamination that renders obvious or anticipates the amended Markush-type claim, the claim will be rejected and the action made **final**. Id.

6. The examiner searched the compound based on the elected species, wherein no prior art was found which anticipates or renders obvious the elected species. Therefore, the prior art search was extended to the compounds of the previous Office action. These compounds were

not found to be allowable over the prior art as described, so the search was not extended further. It has been determined that the entire scope claimed is not patentable.

***Status of the Claims***

7. Currently, claims 1-20 and 31-40 are under consideration.

***Response to Arguments***

8. Applicant's arguments and amendments filed 22 August 2011 have been fully considered and entered into the application. The rejections recited below represent the full set being applied to the instant claims.

***New Rejections Necessitated by Amendment***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

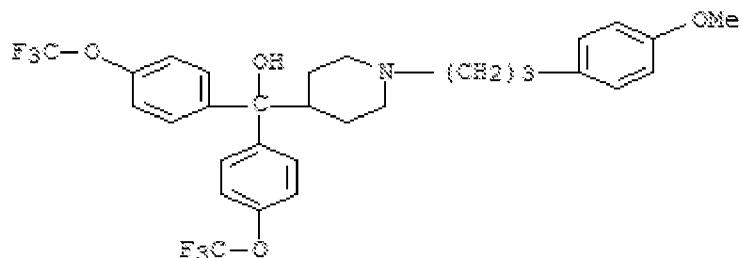
9. Claims 1, 6, 11, 16, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent no. 5,569,664.

Determination of the scope and contents of the prior art

U.S. Patent no. 5,569,664 discloses obvious variants of the instantly claimed compounds.

Ascertaining the differences between the instant claims and the prior art

U.S. Patent no. 5,569,664 teaches the following compounds as insecticides which are homologous with the instantly claimed compounds at the X position where X can be alkyl in the claims and the prior art teaches X is H.



RN 169609-56-7, wherein r and

q are zero, A is CH<sub>2</sub>CH<sub>2</sub>CH<sub>2</sub>, R7, R8, R10 and R11 are H, R9 is methoxy, Y is -OH, m is zero, R is phenyl where R14, R15, R17, and R18 are H and R16 is haloalkyl, and R1 R2 R4 and R5 are H and R3 is haloalkyl. There are other homologous compounds in Table 1, starting in column 41. Also in the subgenus of claim 1, column 84 and species claims beginning with claim 8.

Resolving the level of ordinary skill in the pertinent art – Prima facie case of obviousness

With regards to the H v. alkyl substitution, MPEP 2144.08.II.A.4(c) states, "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties."

To those skilled in the chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. Finally, hydrogen and methyl are deemed obvious variants. *In re Henze*, 85 USPQ 261 (1950), *In re Wood*, 199 USPQ 137 (CCPA 1978), and *In re Lohr*, 137 USPQ 548, 549 (CCPA 1963).

One of ordinary skill would be motivated, from the disclosure in the prior art, to make the modifications required to arrive at the instant invention with reasonable expectation of success for obtaining a compound with the same utility. The motivation to make the change would be to make additional compound for the quoted purpose.

Thus, the instant claims are *prima facie* obvious.

### ***Conclusion***

10. Claims 7-10, 17-20, and 37-40 are allowed.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

/Samantha L. Shterengarts/  
Examiner, Art Unit 1626  
/Rebecca L Anderson/  
Primary Examiner, Art Unit 1626